



IPW

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: YUKI MORIKAWA et al

Art Unit: 1711

Application No.: 10/608,418

Confirmation No.: 8054

Examiner: R. Sergeant

Filed: June 30, 2003

Washington, D.C.

For: NON-AQUEOUS LAMINATE ADHESIVE

Atty.'s Docket: MORIKAWA =5A

Date: January 3, 2005

Customer Window, Mail Stop AMENDMENT
THE COMMISSIONER OF PATENTS AND TRADEMARKS
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

Transmitted herewith is a [XX] REPLY TO ELECTION REQUIREMENT in the above-identified application.

[] Small entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted

[] A verified statement to establish small entity status under 37 CFR 1.9 and 1.27 is enclosed.

[XX] No additional fee is required.

The fee has been calculated as shown below:

(Col. 1)		(Col. 2)		(Col. 3)
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA EQUALS
TOTAL	*	MINUS	** 20	0
INDEP.	*	MINUS	*** 3	0
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM				

SMALL ENTITY	
RATE	ADDITIONAL FEE
x 25	\$
x 100	\$
+ 180	\$
ADDITIONAL FEE TOTAL	

OTHER THAN SMALL ENTITY	
RATE	ADDITIONAL FEE
x 50	\$
x 200	\$
+ 360	\$
TOTAL	

- * If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.
- ** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.
- *** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

[XX] Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

[] It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

Small Entity
Response Filed Within
[] First - \$ 60.00
[] Second - \$ 225.00
[] Third - \$ 510.00
[] Fourth - \$ 795.00
Month After Time Period Set

Other Than Small Entity
Response Filed Within
[] First - \$ 120.00
[] Second - \$ 450.00
[] Third - \$ 1020.00
[] Fourth - \$ 1,590.00
Month After Time Period Set

[] Less fees (\$) already paid for month(s) extension of time on .

[] Please charge my Deposit Account No. 02-4035 in the amount of \$.

[] Credit Card Payment Form, PTO-2038, is attached, authorizing payment in the amount of \$.

[] A check in the amount of \$ is attached (check no.).

[XX] The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: MORIKAWA =5A

In re Application of:)	Art Unit: 1711
)	
Yukihiro MORIKAWA et al)	Examiner: R. Sergeant
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Appln. No.: 10/608,418)	Washington, D.C.
)	
Date Filed: June 30, 2003)	Confirmation No. 8054
)	
For: NON-AQUEOUS LAMINATE...)	January 3, 2005

REPLY TO ELECTION REQUIREMENT

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants are in receipt of the Office Action mailed December 13, 2004, largely in the nature of a requirement for election of species.

Acknowledgment by the PTO of the receipt of applicants' papers filed under §119 is noted.

The Office Action indicates that the claims are presently directed to plural inventions which are patentably distinct from one another. As applicants must make an election, even though the requirement is traversed, applicants hereby respectfully and provisionally elect formula (1) of component (a), and formula (5) of component (b), with traverse

and without prejudice. The claims which read on the elected subject matter are **all** the claims, i.e. claims 1-16, with claims 1-12 being generic and claims 13-16 being specific to the elected subject matter.

Applicants do not dispute that the species may indeed be patentably distinct from one another. However, applicants believe that the second paragraph of MPEP 803 controls in the present situation in view of the fact that all of the claims in any event must be searched and examined. In this regard, the second paragraph of MPEP 803 **requires** examination of an entire application, even though the election requirement is correct, if it would not constitute a "serious burden" to do so.

Presumably the examiner will first examine specific claims 13-16, if the elected subject matter has a separate field of search from the other species; and, if such specific claims are then found to be patentable over any prior art found in this field of search, the examiner will then extend the field of search (if different from the first field of search) to one or more of the other species. All this would be consistent with what is required by 37 CFR 1.141 as stated in the fourth paragraph on page 2 of the Office Action.

Withdrawal of the requirement and examination of all the claims on the merits are respectfully requested.


In re of Appln. No. 10/608,418
Amd dated: January 3, 2005
In Reply to OA dated: December 13, 2004

Applicants now respectfully await the results of a
first examination on the merits.

Respectfully submitted,

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